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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GARCIA, ERNESTO

ART UNIT

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3679

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DELIVERY MODE

02/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/525,705	Applicant(s) MATHES ET AL.	
	Examiner ERNESTO GARCIA	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

The drawings were received on November 14, 2008. These drawings are accepted. However, the drawings contain a few discrepancies.

The drawings are objected to because Figure 6 is not a representation of Figure 4 when the screw is bent. Note that the elastomer E is missing and the shank relative to the head is offset. Figure 6 also contain in incorrect cross-hatching thus representing parts 2 and 14 being elastomeric. Figures 4 and 6 contain a dimension within dimension Lb that is not labeled. Figure 6 also contains a dimension Dt that should be deleted as the dimension does not point to anything. The same goes for dimension D in Figure 6.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 1 is objected to because of the following informalities:

regarding claim 1, "coaxial" in line 4 should be deleted as the location of the flange cannot be made to components not claimed, i.e., the suction orifice. Note that this adjective raises the question as to what the flange is coaxial with. The comma in line 5 should be deleted. The recitation "heads fitted" in line 8 requires rephrasing as the heads are not fitted but the screws. Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

Claim Rejections - 35 USC § 112

Claims 1-9 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, there is still an inconsistency between the language in the preamble and a certain portion in the body of the claim, thereby making the scope of the claims unclear. The preamble clearly indicated that the fastener system is “for fastening a vacuum pump (1) to a wall (2) of a stationary structure (3), having tapped holes (15) provided in the wall (2) of the stationary structure (3)”. However, the body of the claim positively recites the wall, having the tapped holes (15), e.g., “their shanks (19) ... are screwed into corresponding ones of the tapped holes” (lines 8-9). Accordingly, is the combination or subcombination being claimed? Appropriate correction, clarification, or both is required. For purposes of this Office action, the examiner has considered the wall as being part of the fastener system as a combination.

Applicants argue that the tapped holes “are merely used to describe the relative structure and function of the positively recited screws”. In response, the claimed language at lines 8-9 does not imply relative structure and function. Instead, the language at lines 8-9 is a requirement of the structure of the fastener system and in particular of the shanks. The requirement is that the “shanks pass through the through

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holes" and "screwed into .. the tapped holes". Therefore, this is not merely a function and a relative structure but rather a positive requirement or required structure.

Regarding claims 3-9 and 18, the claims depend from claim 1 and therefore are indefinite.

Claim Rejections - 35 USC § 102

Claims 1, 2, 11-14, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Potts, 2,748,578.

Regarding claim 1, Potts discloses, in Figure 1, a fastener system comprising a coaxial annular flange **16**, tapped holes **A1** (see marked-up attachment provided in the Office action dated June 6, 2007), through holes **A2**, and screws **32**. The tapped holes **A1** are provided in a wall of a stationary structure **30**. The through holes **A2** are provided in the flange **16**. The screws **32** have heads and shanks. The shanks pass through the through holes **A2** and are screwed into the tapped holes **A1**. Each of the through holes **A2** comprises a distal segment **A3** followed by an enlarged proximal segment **A4**. The distal segment **A3** is cylindrical and the enlarged proximal segment **A4** is cylindrical about the same axis.

Regarding claim 2, given the structure of claim 1, the proximal segment **A4** of the through hole would allow a maximum lateral offset between the through hole and the corresponding tapped hole is greater than the radius of the screw shank. The proximal segment **A4** is of a length greater than the length of the distal segment **A3**.

Regarding claim 11, Potts discloses, in Figures 1 and 4, a faster system comprising a screw **32**, a flange **16**, and a stationary structure **30**. The screw comprises a head and a shank. The flange **16** comprises a through hole **A2**. The through hole **A2** comprises a distal segment **A3**, and a proximal segment **A4**. The stationary structure **30** has a hole **A1**. A cross-sectional area of the distal segment **A3** taken in a direction perpendicular to a central axis of the through hole **A2** is smaller than that of the proximal segment **A4**. The proximal segment **A4** provides a gap (when the shank is being inserted). The proximal segment **A4** has an opening sized differently from the hole **A1** in the stationary structure **30**.

Regarding claim 12, the proximal segment **A4** has an opening larger than the hole **A1** in the stationary structure **30**.

Regarding claim 13, a distance measured in a radial direction of the through hole **A2** between an inside wall of the proximal segment **A4** and an opposing outside surface of the screw shank when the screw is fully inserted in the through hole **A2** is greater than a radius of the screw shank. Applicants should note that this claim does not

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indicate that the screw has to be sitting or abutting. Merely inserting the shank without being inserted in the hole in the stationary structure anticipates the subject matter because the shank in the through hole is considered to be “fully inserted” during insertion.

Regarding claim 14, the proximal segment **A4** has a length greater than a total length of the distal segment **A3**.

Regarding claim 18, each of the proximal segments **A4** has an opening greater than an outermost opening of the tapped holes **A1**.

Claims 11, 12, 15, and 16 are rejected under 35 U.S.C. 103(a) as being anticipated by Cline, 2,083,054.

Regarding claim 11, Cline discloses, in Figure 1, a faster system comprising a screw **19**, an annular flange **12**, and a stationary structure **13**. The screw **19** comprises a head **20** and a shank. The flange **12** comprises a through hole **14**. The through hole **14** comprises a distal segment (the cylindrical portion of the hole **14**), and a proximal segment (the enlarged portion of the hole **14**). The stationary structure **13** has a hole **15**. A cross-sectional area of the distal segment taken in a direction perpendicular to a central axis of the through hole **14** is smaller than that of the proximal segment (the enlarged portion of the hole). The proximal segment provides a gap. The proximal

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segment has an opening **A1** (see marked-up attachment) sized differently from the hole **15** in the stationary structure **13**.

Regarding claim 12, the proximal segment has an opening **A1** (see marked-up attachment) that is larger than the hole **15** in the structure **13**.

Regarding claim 15, the shank comprises, adjacent to the head, a smooth shank segment of a diameter substantially smaller than a diameter of the distal segment of the through hole, and is followed to a free end by a threaded segment.

Regarding claim 16, the diameter of the smooth shank segment is less than or equal to 80% of the diameter of the distal segment of the through hole.

Claim Rejections - 35 USC § 103

Claims 5, 6, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potts, 2,748,578, in view of Allart et al., 5,220,854.

Regarding claims 5 and 15, Potts, as discussed, fails to disclose the screw shank comprises, adjacent to the head, a smooth shank segment of diameter considerably smaller than the diameter of the distal segment **A3** and followed to a free end by a threaded segment. Allart et al. teach, in Figure 1, a screw shank comprising, adjacent

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to a head, a smooth shank segment of diameter that is considerably smaller than the diameter of a distal segment of a through hole and the smooth shank is followed to a free end by a threaded segment to prevent from threading the shank all the way towards the head since such design will save manufacturing costs and time of manufacturing. Therefore, as taught by Allart et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a smooth shank segment, adjacent to the head, of diameter smaller than the diameter of the distal segment **A3** of Potts and the smooth shank is followed to a free end by a threaded segment to save manufacturing costs and time instead of threading the shank all the way up to the head of the screw.

Regarding claims 6 and 16, given the modification, it would have been obvious matter of design choice to design the diameter of the smooth shank segment less than or equal to 80% of that of the distal segment since such clearance J, as taught by Allart et al. (Fig. 5), prevents the thread from being damaged. Therefore, as taught by Allart et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the smooth shank segment with a diameter less than or equal to 80% of that of the distal segment to prevent the thread from being damage while being inserted in the through hole.

Regarding claim 17, Potts discloses the proximal segment **A4** having a length greater than or equal to 1.5 time a length of the distal segment **A3**.

Claims 1, 3, 4, 7, 9, and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlson, 2,560,413, in view of Weis, 1,831,430.

Regarding claim 1, Carlson discloses, in Figures 1 and 4, a faster system comprising a screw **16**, a flange **A1** (see marked-up attachment provided in the Office action dated June 6, 2007), and a stationary structure **14**. The screw comprises a head and a shank. The flange **A1** comprises a through hole **22**. The through hole **22** comprises a distal segment **28**, and a proximal segment **A2**. The stationary structure **14** has tapped holes **26**. However, the flange **A1** in Carlson is not annular in any respect but appears square or does the flange include more than one through hole **22**. Weis teaches, in Figure 4, a flange that is annular as part of a design consideration instead of being any other shape than square since rounding the flange to be annular provides for an increase in material toward an outside wall which will handle more stresses than merely being square. Therefore, as taught by Weis, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the flange annular to provide more material toward the outside wall to handle more stresses during operation of the connection. Further, Applicants are reminded that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide more than one through hole in the flange **A1** of Carlson so that more than one screw provides twice as much clamping force than using

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one through hole in the flange **A1** and one screw. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 3, the proximal segment **A2** includes a cylindrical proximal portion **A4** connected to the distal segment **28** by a circularly frustoconical distal portion **A3**.

Regarding claim 4, the frustoconical portion **A3** has a cone half-angle equal to about 60 degrees.

Regarding claim 9, Carlson discloses the system further comprises a material inserted in a space between the shank and the through hole. However, the material is not an elastomer damper (as seen by the cross-section). However, Carlson suggests, in column 4, lines 10-16, any material possessing qualities of flowing and conforming to the bores can be used). Thus, one can use rubber, an elastomer damper material, since rubber possesses qualities of flowing and conforming to bores when being compressed. Therefore, as taught by Carlson, it would have been obvious to one of ordinary skill in the art at the time the invention was made to choose rubber, an elastomer damper material, since rubber flows and conforms to bores when being compressed.

Regarding claim 11, Carlson discloses, in Figures 1 and 4, a faster system comprising a screw **16**, a flange **A1** (see marked-up attachment), and a stationary structure **14**. The screw comprises a head and a shank. The flange **A1** comprises a through hole **22**. The through hole **22** comprises a distal segment **28**, and a proximal segment **A2**. The stationary structure **14** has a hole **26**. A cross-sectional area of the distal segment **28** taken in a direction perpendicular to a central axis of the through hole **22** is smaller than that of the proximal segment **A2**. The proximal segment **A2** provides a gap. The proximal segment **A2** has an opening sized differently from the hole **26** in the stationary structure **14**. However, the flange **A1** in Carlson is not annular in any respect but appears square. Weis teaches, in Figure 4, a flange that is annular as part of a design consideration instead of being any other shape than square since rounding the flange to be annular provides for an increase in material toward an outside wall which will handle more stresses than merely being square. Therefore, as taught by Weis, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the flange annular to provide more material toward the outside wall to handle more stresses during operation of the connection.

Regarding claim 12, the proximal segment **A2** has an opening larger than the hole **26** in the stationary structure **14**.

Regarding claim 13, a distance measured in a radial direction of the through hole **22** between an inside wall of the proximal segment **A2** and an opposing outside surface

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of the screw shank when the screw is fully inserted in the through hole **22** is greater than a radius of the screw shank.

Regarding claim 15, the screw shank comprises, adjacent to the head, a smooth shank segment of diameter considerably smaller than the diameter of the distal segment **28** and followed to a free end by a threaded segment.

Regarding claim 16, the diameter of the smooth shank segment is less than or equal to 80% of that of the distal segment **28**.

Regarding claims 7, 14 and 17, Carlson, as modified, fails to disclose the proximal segment **A2** having a length greater than or equal to 1.5 times a length of the distal segment **28**. Applicants are reminded that a change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would have been an obvious matter of design choice to decrease the length, i.e., the depth, of the distal segment **28** so that the proximal segment will have a length greater than or equal to 1.5 times the length of the distal segment **28** since such a modification would have involved a mere change in the size of a component. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carlson, 2,560,413, in view of Weis, 1,831,430, as applied to claims 1, 3, 4, 7, 9, and 11-17, and further in view of Monette, 5,203,441.

Regarding claim 8, Carlson, as modified, fails to disclose a washer interposed between the head of the screw and an adjacent outside face of the flange. Monette teaches, in Figure 5, a washer 57 interposed between a head of a screw 55 and an adjacent outside face of a flange 29 to lock the screw from coming loose. Therefore, as taught by Monette, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a washer 57 interposed between the head of the screw in Carlson to prevent the screw from coming loose.

Claims 13, 14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cline, 2,083,054.

Regarding claim 13, Cline, as discussed, fails to disclose a distance measured in a radial direction of the through hole between an inside wall of the proximal segment and an opposing outside surface of the screw shank being greater than a radius of the screw shank. Cline suggests on column 2, lines 34-38, that the proximal segment permit bending. Since the amount of bending is relative to the sized of hole already shown, it would have been obvious to increase the sized of the hole to further increase the amount of bending. Therefore, it would have been obvious to one of ordinary skill in

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the art at the time the invention was made to change the size of the proximal segment so that the distance measured in the radial direction of the through hole between an inside wall of the proximal segment and an outside surface of the screw shank is greater than a radius of the screw shank so that the amount of bending can be increased. Note that the screw shank could have been modified as well so that the screw is much smaller and the distance would have increased.

Regarding claims 14 and 17, Cline, as discussed, fails to disclose the proximal segment of the through hole being of a length greater than a total length of the distal segment. As previously suggested by Cline at column 2, lines 34-38, the proximal segment allows for bending; therefore, one would have modified the size of the proximal segment so that the through hole is of a length greater than that of the distal segment or 1.5 times greater than that of the distal segment in order to increase the amount of bending. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to increase the length of the proximal segment of the through hole to be greater than that of the distal segment in order to increase the amount of bending.

Response to Arguments

Applicants' arguments filed November 14, 2008 have been fully considered but they are not persuasive. In particular, note the pending 35 USC 112, 2nd paragraph, rejections.

With respect to Potts, applicants argue that the examiner has ignored the limitation "where said proximal segment (16b) is configured to be provided adjacent to the corresponding tapped hole of the stationary structure". In response, this limitation is of such breadth that it does not set forth any actual configuration of the proximal segment. In other words, what particular configuration is being required? None has been set forth. Potts clearly possesses a "configuration" and applicants have failed to show that such configuration is incapable of being provided adjacent a tapped hole of a stationary structure. Further, based on the applicants' comments that the tapped holes are not an actual part of the system, the proximal segment is not required to actually be "adjacent to the tapped hole"; it only need be capable of being provided adjacent to the tapped hole. Note that it is the structure of the fastener system for which patentability is to be determined and not how such structure is intended to be used. Accordingly, if the tapped holes and their specific relationship to the respective proximal segment is critical to the patentability of applicants' invention, then such needs to be positively set forth and required by the language of the claims.

Applicants further argue that the examiner's statement that "the tapped holes and the stationary structure are not claimed" contradicts the examiner's statement that the "body of the claim positively recites the wall, having the tapped holes (15)". In response, it should be noted that the examiner's statement is taken out of context by the applicants as the examiner previously noted a problem with the claims and then took a position on the intended meaning of the claim language, such meaning having been confirmed by applicants own remarks as correct (see page 10). Specifically, applicants clearly state that the tapped holes are merely used "to describe the relative structure and function of the positively recited screws. The claimed fastener system does not require the wall and the tapped holes, nor are the wall and tapped holes positively recited in the claim." Accordingly, how do the recitations concerning the tapped holes serve to patentably distinguish the fastener system of the claimed invention from the prior art when such are not even required features of the claim? The answer is that they don't.

Applicants further argues that examiner must give patentable weight to the above claim feature. This is incorrect because such feature is not a required element of the claims. Claim 1 merely requires a flange, through holes, and a screw. These are the features that are listed in claim 1. Applicants are reminded that patentability is based on the structural features recited and not on the potential interaction with non-positively recited structure, i.e., functional relationships.

Applicants argue that the device of Potts would require the collar 15 to be inverted relative to the collar 24. In response, it is unclear why the collar has to be inverted when the shown structure of Potts still places the proximal end adjacent to a tapped hole. Accordingly, this is not necessary. It should also be noted that the term “adjacent” is of such breadth that any location of the proximal end still places the proximal end adjacent to the tapped hole. In other words, what constitutes being adjacent relative to each other? Note that as long as the proximal end is nearby to the tapped hole, this constitutes being “adjacent”.

With respect to claim 2, applicants argue that the screw shank would not come into abutment against the side wall of the proximal segment but rather would abut the side wall of the alleged distal segment A3. In response, it should be noted that it is not a requirement that the shank be in abutment with the proximal segment. Claim 2 merely recites a possibility which Potts is capable of doing. As has been well-settled by case law, a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if all structural limitations of the claim are taught. See *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997), *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987) and MPEP 2114. Applicants have not argued what in the claims is structurally different to distinguish over Potts. Given that the same structures are present, the system would inherently perform as claimed.

With respect to Cline, applicants argue that the opening of the proximal segment A1 is the same size as the alleged hole opening A2. In response, this has not been found persuasive since applicants' analysis is incorrect. It seems that the applicants have considered the portions to be the openings. The examiner has merely taken the mouth of the opening to be of different sizes since the portions are tapered. Note that the lead lines of reference characters A1, A2 of the marked-up attachment point to two different openings and not the same sized openings. Accordingly, these openings are of different sizes.

Applicants argue that the bolts will break and that the proximal segment provides a gap in which the shank can bend while maintaining the vacuum pump fastened to the stationary structure. In response, the examiner has established a gap in Cline. Further, it should be noted that the language "can bend" does not mean the shank bends. This means the shank could or could not bend. Further, it should be noted that the vacuum pump is not claimed and any argument related to the vacuum pump is irrelevant to the claimed fastener system.

With respect to claim 15, applicants argue that the claimed distal segment has nearly the same diameter of the elongated shank segment of the bolt 19. In response, applicants should note that the term "nearly" does not mean the same. Further, if the diameter of the distal segment were the same as that of the shank, the shank would not be allowed to be inserted into the distal segment. This can only occur if the shank is

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smaller than the hole. This is the mechanics used to allow something to be inserted into a hole otherwise it would have been press-fitted when the shank is larger than the hole.

With respect to claim 16, applicants argue that the examiner has not identified any portion of the reference to support that the shank segment is less than or equal to 80% of the diameter of the distal segment of the through hole. In response, one can simply take a ruler and measure the diameter of the shank and that of distal segment, i.e., the enlarged portion A1 of the hole. Note that the dimension at A1 is larger than that of the shank.

With respect to Carlson, claim 1, applicants argue that Carlson fails to teach the claimed feature that the through hole is allowed to be offset laterally correspond relative to the associated corresponding tapped hole. In response, it should be noted that this is not a structural feature but rather a capability or what the invention is intended to perform. It should be noted that patentability is based on the structural differences and not what the device does or performs. Further, it would be inherent that the through hole will be allowed to be offset laterally relative to a tapped hole, given that the same structural features, as claimed, are met by Carlson.

Applicants further argue that Carlson teaches that the bushing is used to maintain the alignment of the bores and does not allow the holes to be laterally offset from each other. In response, it seems that the applicants are evaluating the invention

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of Carlson being assembled when the examiner is relying simply upon the teachings of the flange, the screws and the holes. These three features, as only required by claim 1, and would inherently allow offsetting. Note that the other components in Carlson are not needed as the claimed fastening system is not an assembled system but rather a listing of parts. Note that the flange, the screw and the holes would inherently allow offsetting when they are evaluated by themselves. Applicants seem to be evaluating the claimed invention as it were an assembled system when claim 1 is merely a listing of three parts as best understood by the applicants' arguments. Obviously, if the same parts listed are found in Carlson, then the parts will inherently perform in any matter even to allow offsetting. It should be noted that the recitation "the through hole (16) is allowed to be offset laterally (D) correspondingly relative to the associated corresponding tapped hole (15)" does not impart any structure that defines over the prior art but rather what the through hole does. Obviously, any through hole will be allowed to be offset. There's nothing different about the claimed through hole over that of Carlson. If applicants are concerned about the method of offsetting holes, then applicants should considered applying for a divisional application setting forth the method of allowing offsetting holes rather than arguing that the holes are offset in this application when the claim does not set forth any positive limitation that the holes are actually offset as part of the requirement. Again, patentability is based on the structural differences and not on their functions or how the device operates.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached Monday through Friday from 9:30AM-6:00PM. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/E. G./

Examiner, Art Unit 3679

February 3, 2009

/Daniel P. Stodola/
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